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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/472,490	12/23/1999	RUY TCHAO	102-302RE/CO	8828

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SYOSSET, NY 11791

EXAMINER
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WONG, LESLIE A

ART UNIT	PAPER NUMBER
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1761

18

DATE MAILED: 06/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/472,490

Applicant(s)  
Tchao

Examiner  
Leslie Wong

Art Unit  
1761



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Oct 21, 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 46-50 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 46-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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In view of the fact that additional errors in the original patent have been corrected through amendments to the claims, a new/supplemental oath or declaration complying with 37 CFR 1.63 and 1.175 is required.

In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

Claims 1-15 and 46-50 are rejected as being based upon a defective declaration under 35 U.S.C. 251. See 37 CFR 1.175. The nature of the defect is set forth above.

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

Claim 49 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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Claims 46-48 and 50 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for non-destructive chemotaxis assays, does not reasonably provide enablement for any and all types of non-destructive assays. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

Applicant does not teach any and all types of non-destructive assays. Only non-destructive chemotaxis assays are contemplated. Applicant does not consider other non-destructive assays such as stereotaxis, phototaxis, electrotaxis, or geotaxis assays. To make and use the invention with non-destructive assays, other than chemotaxis, would involve extensive experimentation.

Nowhere in the specification does Applicant contemplate any assay other than a chemotaxis assay. Applicant states on column 2, lines 32-36, that "I have developed a chemotaxis assay procedure ...", where the entire specification is specifically directed to a chemotaxis assay. Applicant does not consider other non-destructive assays such as stereotaxis, phototaxis, electrotaxis, or geotaxis assays. The assays are entirely different and the use of other assays would require extensive experimentation.

Claims 46-48 and 50 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for chemical agents, does not reasonably provide enablement for any and all types of agents. The specification does not enable any person skilled in the art to

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which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

Applicant does not teach any and all types of agents. Only chemical agents are contemplated. To make and use the invention with an agent other than a chemical agent would involve extensive experimentation.

Claims 46-48 and 50 are rejected under 35 U.S.C. 251 as being improperly broadened in a reissue application.

The claims have been broadened as Applicant does not teach any and all types of non-destructive assays or any and all types of inducing agents

Applicant's arguments filed October 21, 2002 have been fully considered but they are not persuasive.

Applicant argues that the invention is not limited to a chemotaxis assay as chemotaxis is only the preferred embodiment.

As stated above and as set forth in previous Office actions (Paper Nos. 3, 7, and 16), nowhere in the specification does Applicant contemplate any assay other than a chemotaxis assay. Applicant states on column 2, lines 32-36, that "I have developed a chemotaxis assay procedure ...", where the entire specification is specifically directed to a chemotaxis assay. Applicant does not consider other non-destructive assays such as stereotaxis, phototaxis, electrotaxis, or geotaxis

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assays. The assays are entirely different and the use of other assays would require extensive experimentation.

Applicant refers to columns 4-6 for support, but nowhere in these specific passages or the entire specification does Applicant specifically teach that chemotaxis is merely the preferred embodiment. Nowhere in these passages or the entire specification does Applicant even contemplate anything other than chemotaxis.

All of the claim limitations have been considered.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

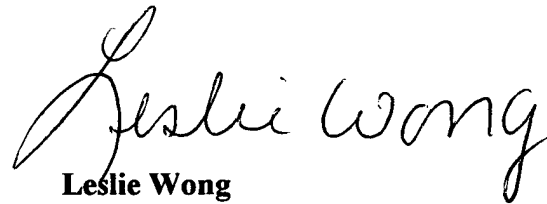
A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leslie Wong whose telephone number is (703) 308-1979. The examiner can normally be reached on Tuesday-Friday.

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The fax number for this Group is (703) 872-9310 for non-final responses and (703) 872-9311 for after-final responses.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.

A handwritten signature in cursive script that reads "Leslie Wong". The signature is written in black ink and is positioned above the printed name and title.

**Leslie Wong**  
**Primary Examiner**  
**Art Unit 1761**

LAW  
April 30, 2003